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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/387,443      | 09/01/1999  | WILLIAM KOPACIEWICZ  | 550P002CONT.        | 2583             |

7590 11/27/2002

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[REDACTED] EXAMINER

FORTUNA, ANA M

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1723

DATE MAILED: 11/27/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

|                               |                            |
|-------------------------------|----------------------------|
| Application No.<br>09/387,443 | Applicant(s)<br>Kopaciewcz |
| Examiner<br>Ana Fortuna       | Art Unit<br>1723           |



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on Mar 8, 2002
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- 4)  Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-18 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 and 9      6)  Other: \_\_\_\_\_

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## DETAILED ACTION

Rejection of the claims in paper No. 3 has been withdrawn. According to the amendments to 102 (e) (H.R. 2215). Newly published reference US 6,451,260 B1, which is based on WO 98/08494 and EP 086412 A3, does not qualify as 102 (e). Neither of the International Applications above (WO and EP) qualify as prior art. A new ground of rejection based on newly Applicant's cited prior art is discussed below.

### *Claim Rejections - 35 U.S.C. § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 12, 6-9, 11, 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nochumson et al (5,552,325)(hereinafter '325). Reference '325 discloses a filtration device including a container containing a structure (filter or membrane 21) comprising a plurality of sorptive particles bound to a polymer adhered to said interior wall (elements 20, 21, 23, sole figure, column 7, lines 32-48). As to claims 1, and 9, the sorptive particles are disclosed, e.g silica (column 5, lines 44-68, through column 6, lines 1-10). As silica as to claims 6-8, 16 -18 the housing material is disclosed, e.g. polypropylene, polyethylene, etc (column 8, lines 35-47).The polymer for the matrix or membrane, e.g. polysulfone, etc. is disclosed between others (column 9, lines 1-10). As to claim 11, the housing or container having the filter adhered to the interior wall

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is disclosed (adhered by definition includes "holding or held fast"), since the filter in reference '325 covers the bottom of the container so that fluid cannot pass from the interior of the container (20) without first passing through the filter means or membrane (or selection means (21)). Therefore filter 21 is adhered or tight to the interior wall of the container enough to avoid passage of the fluid to be filtered out of the container without passing though the filter.

3. Claims 1, 2, 11, 12, 3, 4, 5, 14, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by White(5,156,811). White ('811) discloses a housing of pipette having the configuration claimed in claims 2, 11, 4, 14, and having a structure (porous plug) comprising sorptive particles bound to a polymer adhered to said interior wall (abstract, Fig. Element 18, 12). The plug is also defined as physically attached (adhered) to the inner wall of the housing (column 2, lines 46-5), and made of polymer such as polyethylene (column 4, second paragraph), and containing adsorbing particles (column 5, lines 19-26).

#### ***Claim Rejections - 35 U.S.C. § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deer Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 10, 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nochumson et al (5,552,325)(hereinafter '325) as applied to claim 1 above and further in view of Hagen et al. (4,810,381) (hereinafter Hagen) or Hilderbrandt et al (4,968,430)(hereinafter '430). '325 teaches silica as sorptive particle in the filter or porous membrane containing sorptive particles,. '325 fails to disclose the silica as "derivitized silica". Hagen teaches a composite filter for chromatography test containing derivitized silica, the derivitized silica as suitable for particulate materials by adsorption separation of specific components for separation and analysis (abstract, column 4, lines 17-37, and column 10, first paragraph). It would have been obvious to one skilled int he art at the time the invention was made to use the silica in a derivitized form, e.g. C18 type silica , as suggested by Hagen (column 4, lines 53-65), and for use in the analysis device of '325, since '325 suggest silica.

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Regarding claims 3 and 13, reference '430 discloses a composite membrane filled with sorptive particles, the polymer can be selected as polysulfone, and the particles as Aerosil 200 (R) Degussa, other adsorptive particles are also disclosed (abstract, column 3, lines 61-68, column 4, lines 1-4, and 24-34). The membrane as having a thickness between 0.5 to 500 micrometers is also disclosed, the use of the membrane in separation of chemical compositions, e.g. liquid permeation, in separation of alcohols, ethers, ketones, carboxylic acids, etc (column 8, lines 63-68, and column 9, lines 1-7). It would have been obvious to one skilled in the art at the time the invention was made to provide a membrane having the thickness within the range disclosed in reference '430 , e.g a flat membrane, in a container or container bottom to form a filtration device capable of separating a particular compound, the container having the structure suggested by '325. It would have been further obvious to select the container volume and membrane thickness such that the membrane occupies a predetermine volume of the container, and it would have been also obvious to one skilled in the art at the time the invention was made to shape a membrane with the thickness disclosed in reference '430, so that the membrane can be fitted within a specifically volume designed housing,, e.g by inserting the membrane within the housing such that only fluid to be filtered pass the membrane, and the membrane is attached to the inner wall f the container, as required by reference '430.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana Fortuna whose telephone number is (703) 308-3857. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached on (703) 308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for regular responses, and (703)872-9311 for after finals.

Ana Fortuna

November 15, 2002



ANALIA FORTUNA  
PRIMARY EXAMINER

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PRIMARY EXAMINER